

App. Ser. No.: 09/440,260

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Confirm. No.: 2733

Inventor: Arthur Jost et al.

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Title: Method and System for Automatically Locating Set-top Terminals
within a Cable Television System

Examiner: Koenig, Andrew Y.

Art Unit: 2623

Atty. Docket No.: D02320

Mail Stop Appeal
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BREIF REQUEST FOR REVIEW

Please review the Final Rejection mailed on June 28, 2006. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal and required fee. The review requested is attached hereto and is not more than five (5) pages.

REQUEST FOR REVIEW

Applicant disagrees with the Examiner's definition of "registration request" used in formulating the rejection. This term is recited in independent claims 1, 11 and 20. The Examiner asserts that a "registration request" should "provide information on the location of the device, which is the broadest reasonable interpretation [of a registration request] and is consistent with the applicant's specification." *See* Advisory Action mailed on August 8, 2006, page 2, paragraph 7. What the Examiner has done has taken his broadest reasonable interpretation of "registration request" to be synonymous with the word "location." This is improper.

First, common dictionary definitions do not support the Examiner's conclusion. Representative dictionary definitions are as follows:

Locate – to designate the site of

Register – to enter in a register, official record, list or roll

As can be plainly seen, these definitions are not the same. Designating where you are in a region is not the same as asking to be put on a particular list. Therefore, the Examiner's broadest interpretation of "registration request" is incorrect.

A more accurate definition for "registration request" includes a REQUEST (the second part of the phrase) to receive configuration information. This definition is supported by the specification. *See generally*, page 11, lines 10-13; page 13, lines 14-17; and page 13, line 24 – page 15, line 3. In these sections of the specification, the set top box needs to receive attributes from the headend in order for it to configure itself to operate properly in the network. *Id.* Merely providing your location does NOT mean that the recipient of your location message will send attributes information down to you.

The Examiner is assuming that knowing a set top box's location will cause the recipient of that location information to provide attribute information without providing any support in any reference.

Similarly, the registration request is treated differently by the present invention than the bit error rate message of Caporizzo. Specifically, the registration request, or at least a portion of it, is used to inform the billing system of a new subscriber. *See* page 11, line 32 – page 12, line 2. Caporizzo's bit rate error messages are used by technicians to repair faulty parts of the network. *See* column 3, lines 39-44. Since both systems use their respective messages differently, it follows that they must have different structures and content.

It should be noted that the Examiner has apparently NOT argued that the bit error rate message of Caporizzo is modified to include anything beyond location information in making this rejection. Such a modification, if contemplated, would also be erroneous. This is because the periodicity of when Caporizzo sends his bit error rate messages is different from the periodicity of the registration request message of the present application.

The Examiner has asserted that it would be obvious to transmit "bit error rates when a new device is added to the system." *See* Final Rejection mailed June 28, 2006, page 3. Since a set top terminal is typically registered only once in great while (i.e., once in a lifetime of the terminal or maybe for a couple of years before it is moved to a different geographic region), the bit error rate would therefore only be reported once in a lifetime or every couple of years. Caporizzo expressly indicates collecting this data on a much more frequent basis. *See* Caporizzo, col. 5, lines 26-30. The "more than once"

collection and reporting of bit error rates allows the “CATV network operator with an invaluable diagnostic tool for detecting and preventing CATV network problems.” *See* Caporizzo, col. 5, lines 60-63. Alternatively, the “registration request” being added to the bit error rate of Caporizzo would mean that a set top box is requesting registration every hour or so. *See* Caporizzo, column 5, lines 56-58. One of ordinary skill in the art would not repeat sending the same message in a day to request attribute information it already obtained in response to an earlier registration request.

In addition, the proposed combination of Caporizzo and Corrigan does not work and destroys the purpose of Caporizzo. The bit error information is a culmination of errors in messages RECEIVED by the set top terminal. *See* Caporizzo, column 5, lines 11-19. This bit rate error information is also channel specific. *See* Caporizzo, column 5, lines 49-51 and column 4, lines 30-37 where it is known VBI data is carried on each separate channel. However, how is a set top terminal that is not yet registered receiving and processing messages to know what the bit error information is? The Examiner’s proposed combination implies that the modified set top terminal will receive programming without registering, and therefore without paying for it. After some predetermined amount of time, the accumulated bit error information is then presumably sent upstream AS a “request registration message.” But again, if the set top terminal is already receiving and processing data, why does it need to register now?

The Examiner responded to this argument by stating “Caporizzo does not explicitly teach that a set top terminal that is not yet registered cannot receive and process messages to what the bit error rate information is.” *See* Advisory Action mailed August 8, 2006, page 2, paragraph 5. The Examiner is assuming a feature in Caporizzo that is

not taught or suggested. In fact, the Examiner ignores explicit teachings in Caporizzo regarding the bit error rate data being channel specific and carried in the VBI data. *See* Caporizzo, column 5, lines 49-51 and column 4, lines 30-37. Caporizzo goes on to say that customers subscribe to and PAY for CATV channels and are upset when a paid for channel is not received. *See* column 3, lines 3-8. Thus, contrary to the Examiner's assertion, Caporizzo expressly teaches that only those set top terminals that are receiving channels, which means they must have already registered, are generating bit error rate information. Thus, according to the Examiner's proposed combination, only those set top terminals that are already registered can send a registration request message/bit error rate message.

Again, the Examiner fails to address the fact that the bit error information is channel specific. Referring to Figure 3, the microprocessor 160 only receives bytes for testing from tuner 130, demodulator 132 and VBI data receiver 134. *See* generally, col. 4, lines 1-14 and col. 5, lines 49-51. In many cable systems, certain subscribers can only receive and display, and therefore process bit error rate information, for certain channels they have agreed to pay for. In the Examiner's proposed combination, each set top terminal would have to tune, demodulate and collect bit error information for EACH channel for a sufficient amount time. Then, the modified set top terminal would have to report that bit error message in order to "register" for EACH channel. Such a set top terminal would have to "register" 100 times in order for the subscriber to watch 100 channels. This doesn't make sense.

For at least these reasons, the Examiner's rejections are improper and should be set aside.

CONCLUSION

No additional fees are believed due. However, the Office is authorized to charge any additional fees or underpayments of fees (including fees for petitions for extensions of time) under 37 C.F.R. 1.16 and 1.17 to account number 502117. Any overpayments should be credited to the same account.

Applicant respectfully requests reconsideration of the present application, withdrawal of the rejections made in the last Office Action and the issuance of a Notice of Allowance. The Applicant's representative can be reached at the below telephone number if the Examiner has any questions.

Respectfully submitted,

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____September 27, 2006____
Date